

Serial No.: 09/685,138
Docket No.: 112-1001
Draft Amendment dated November 20, 2006
Reply to the Office Action of October 18, 2006

REMARKS

Introduction

Applicant notes with appreciation the Examiner's indication that each of the references cited in the Information Disclosure Statement of March 28, 2006 have been considered.

Upon entry of the foregoing amendment, claims 1, 2, 4-8, 21-28, 31, 32 and new claims 33-42 are pending in the application. Withdrawn claims 16-20 have now been canceled. Claims 22 and 24 have been amended.

With reference to new claims 33-42, support for these claims is found in the specification, drawings and claims as originally filed as noted in Table 1 below:

TABLE 1

Claim Number I = Independent D = Dependent	Selected Claim Language	Where Support Found in Specification Originally Filed
33 (I)	an automatically retractable cover having a rectangular cross-section wherein the portable memory device comprises a hole to accommodate a key ring	Figs. 2A, 2B and 2C; original claim 1; specification at pages 4, lines 7-8; page 6, lines 17-21; page 7, lines 1-14; page 8, lines 8-17; Figs. 4A and 4B Figs. 1A, 1B, 2A, 2B, 2C, 3, 4A and 4B; specification at page 4, line 8; original claim 9

Serial No.: 09/685,138

Docket No.: 112-1001

Draft Amendment dated November 20, 2006

Reply to the Office Action of October 18, 2006

Claim Number I = Independent D = Dependent	Selected Claim Language	Where Support Found in Specification Originally Filed
34 (D)	further comprising a flat ledge, wherein the retractable cover is a sliding retractable cover, wherein the retractable sliding cover when retracted exposes the USB connector and when not retracted covers the USB connector, and wherein the retractable sliding cover when retracted slides onto the flat ledge to accommodate the retractable sliding cover while permitting exposure of the USB connector sufficient to be connected to the USB port.	Figs. 2A, 2B, 2C, 4A, and 4B; specification at page 6, lines 17-21; page 7, lines 1-14; page 8, lines 8-17
35 (D)	further comprising a housing to accommodate the memory and the USB interface	Figs. 1A, 1B, 2A, 2B, 2C, 3, 4A, and 4B; specification at page 4, lines 6-7; original claim 11
36 (D)	further comprising a housing to accommodate the memory and the USB interface	Figs. 1A, 1B, 2A, 2B, 2C, 3, 4A, and 4B; specification at page 4, lines 6-7; original claim 11
37 (D)	wherein the flat ledge has an overall thickness less than an overall thickness of the housing and the flat ledge is attached to the USB connector at an end and to the housing or the USB interface at another end	Figs. 2A, 2B, 2C, 4A and 4B; specification at page 4, line 21; page 5, lines 1, 4-6; page 6, lines 17-21; page 7, lines 1-14; page 8, lines 8-17

Serial No.: 09/685,138
Docket No.: 112-1001
Draft Amendment dated November 20, 2006
Reply to the Office Action of October 18, 2006

Claim Number I = Independent D = Dependent	Selected Claim Language	Where Support Found in Specification Originally Filed
38 (D)	wherein the cover has an overall interior opening of a thickness greater than the overall thickness of the flat ledge	Figs. 2A, 2B, 2C, 4A, and 4B; specification at page 4, line 21; page 5, lines 1, 4-6; page 6, lines 17-21; page 7, lines 1-14; page 8, lines 8-17
39 (D)	the flat ledge further comprises a spring or a groove and the cover, the housing, the USB connector and the flat ledge have a rectangular cross-sectional shape	Figs. 2A, 2B, 2C, 4A, and 4B; specification at page 6, lines 17-21; page 7, lines 1-14; page 8, lines 8-17;
40 (D)	the hole has an oval shape	Figs. 1A, 1B, 2A, 2B, 2C, 3, 4A and 4B; specification at page 4, line 8; original claim 9
41 (D)	wherein the thickness of the retractable cover equals the overall thickness of the housing minus the overall thickness of the flat ledge	Figs. 2A, 2B, 2C, 4A, and 4B; specification at page 4, line 21; page 5, lines 1, 4-6; page 6, lines 17-21; page 7, lines 1-14; page 8, lines 8-17
42 (D)	wherein the overall thickness of the retractable cover equals the overall thickness of the housing	Figs. 2A, 2B, 2C, 4A, and 4B; specification at page 4, line 21; page 5, lines 1, 4-6; page 6, lines 17-21; page 7, lines 1-14; page 8, lines 8-17

Accordingly, no new matter is being presented. In view of the following remarks, reconsideration and allowance of all the pending claims are requested.

Defective Oath or Declaration

For the reasons noted at pages 2-3, paragraph 3, of the Office Action, a new oath or declaration that is "legible" is requested. In response, Applicant submits a clean, legible oath or declaration sufficiently in compliance with 37 C.F.R. 1.67(a). Applicant requests confirmation that the new oath or declaration submitted herewith is acceptable.

Serial No.: 09/685,138
Docket No.: 112-1001
Draft Amendment dated November 20, 2006
Reply to the Office Action of October 18, 2006

Rejection under 35 USC § 112, first paragraph

Claims 22-23 have been rejected under 35 U.S.C. § 112, "first paragraph, as failing to comply with the enablement requirement" for the reasons noted at page 3, paragraph 6, of the Office Action.

Applicant has deleted the language pointed out by the Examiner (see claims 22-23 at page 4) from claim 22 in order to address the Examiner's concerns and to help expedite prosecution (and by virtue of its dependency from claim 23 as well).

In view of the above, Applicant respectfully requests reconsideration and withdrawal of the rejection of claims 22-23 under 35 U.S.C. § 112, first paragraph.

Rejection under 35 USC § 112, second paragraph

Claim 24 has been rejected under 35 U.S.C. § 112, "second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention" for the reasons noted at page 3, paragraph 7, of the Office Action.

Applicant has amended claim 24 to depend from claim 22 rather than from claim 1 in order to help expedite prosecution and to address the Examiner's concerns. Note that base claim 22 provides requisite antecedent basis sought for "said housing".

In view of the above, Applicant respectfully requests reconsideration and withdrawal of the rejection of claim 24 under 35 U.S.C. 112, second paragraph.

First Rejection under 35 USC § 103

Claims 1, 2, 4-8, 21-24 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over MacHASP USB – Software Protection via the USB by Aladdin Knowledge System published October 1998 (hereinafter "MacHASP") in view of CN 2032364U to Liu (hereinafter "Liu"), and further in view of U.S. Patent No. 6,148,354 to Ban (hereinafter "Ban") for the reasons noted at pages 4-7, paragraphs 11-14, of the Office Action.

Applicant respectfully traverses the foregoing rejection for at least the reasons noted below. In particular, the primary reference (MacHASP) contains 2 pages, the last of which

Serial No.: 09/685,138

Docket No.: 112-1001

Draft Amendment dated November 20, 2006

Reply to the Office Action of October 18, 2006

indicates a date of "10/1998". However, these 2 pages do not disclose, teach or suggest the presence of any cover to protect the USB connector recited in the rejected claims.

Additionally, the Office Action cites to 2 additional pages as part of MacHASP, the first page of which contains the handwritten remark "Evidence 2". It is noted that these additional pages do not contain any publication date. As such, Applicant submits that these pages do not qualify as citable art unless it is unequivocally established that these 2 additional pages were published before the priority date of the currently rejected application (note that the priority date of the currently rejected application = 11 October 1999). For the Examiner's convenience, the relevant pages of MacHASP are attached hereto.

Nevertheless, assuming arguendo (without conceding same) that the pages showing a picture of a USB device is a citable reference, Applicant respectfully submits that the picture of the USB device most noticeably is not provided with a cover – much less a retractable cover or one that is "capable of sliding automatically backwards" as recited in Applicant's pending claims.

In other words, pursuant to MacHASP, one of ordinary skill in the art would have unequivocally concluded that the USB device does not require a cover as recited in Applicant's claims. So, the only place the suggestion or motivation to provide a cover for the claimed portable memory device must have come from is within Applicant's own specification. To rely on such teaching from Applicant's own specification to add a cover amounts to impermissible use of hindsight reconstruction.

Furthermore, reliance on the secondary reference Liu for its disclosure of an electrical plug cover is improper for various reasons including (1) use of impermissible hindsight to assert the missing suggestion or teaching to provide a protective cover, (2) use of Liu as "analogous art" when, in fact, Liu is "non-analogous art" – taking into consideration that Liu is directed to covering the prongs of an electrical plug attached to a powered device – typically done to prevent shock at the 110V or 220V potentially lethal voltage of socket powered electrical devices, and (3) even if combined (though impermissibly with MacHASP), the combination does not yield Applicant's claimed invention because the cover of Liu would not be suitable for a USB device - because - for one, it is of a circular shape and – and therefore – the cover of Liu would

Serial No.: 09/685,138
Docket No.: 112-1001
Draft Amendment dated November 20, 2006
Reply to the Office Action of October 18, 2006

have to be modified to fit an USB device – and – there is no teaching, suggestion or disclosure in MacHASP or Liu to do so.

With regard to reliance on Ban, which the Examiner uses to merely illustrate “a USB interface coupled between a USB connector and a memory to interface the memory with a data processing system,” such secondary reference (Ban) does not rectify the deficiencies of MacHASP and/or Liu. Accordingly, Applicant respectfully submits that claims 1, 2, 4-8, 21-24 are patentable over MacHASP in view of Liu and further in view of Ban.

Accordingly, Applicant respectfully requests reconsideration and withdrawal of the above-noted rejection of claims 1, 2, 4-8, 21-24 under 35 U.S.C. § 103(a) over MacHASP in view of Liu and further in view of Ban.

Also, with reference to new claims 33-42, Applicant significantly notes that in addition to the “retractable cover” recited in these new claims, these new claims also recite a “hole to accommodate a key ring.” Certainly, the Liu reference is non-analogous art directed to covering an electrical prong attached to a power cable. As such, it is not a device that one of ordinary skill would have been motivated to provide a hole to “accommodate a key ring.” Further, the new claims recite additional features (e.g., rectangular cross-section, flat ledge, various thicknesses) not taught, disclosed or suggested in any of the cited references. See claims 33-42 and Table 1 herein. Thus, claims 33-42 are patentable over the cited references.

Second Rejection under 35 USC § 103

Claims 25-28, and 31-32 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,038,320 to Miller (hereinafter “Miller”) in view of U.S. Patent No. 6,292,890 to Crisan (hereinafter “Crisan”) and further in view of Liu for the reasons noted at pages 7-9, paragraphs 16-18, of the Office Action. Applicant respectfully traverses this rejection for the reasons noted below.

In particular, Applicant’s above-noted remarks with regard to the deficiencies of Miller and Liu are equally applicable to this above noted rejection without having to repeat the same here. However, Applicant incorporates his above-noted remarks regarding Miller and Liu as if restated here.

Serial No.: 09/685,138
Docket No.: 112-1001
Draft Amendment dated November 20, 2006
Reply to the Office Action of October 18, 2006

Neither Miller nor Crisan teach, disclose or suggest the use of a retractable cover (e.g., protective cover) as recited in Applicant's claims. Liu does not correct that deficiency for the reasons already noted. Accordingly, Applicant respectfully submits that claims 25-28, 31-32 rejected under 35 U.S.C. § 103(a) are patentable over Miller in view of Crisan further in view of Liu.

Therefore, Applicant respectfully requests reconsideration and withdrawal of the above-noted rejection of claims 25-28, and 31-32 under 35 U.S.C. § 103(a) over Miller in view of Crisan further in view of Liu.

Provisional Obviousness-type Double Patenting Rejection

Claims 1, 2, 4-8, 21-23, 24, 25-28, and 31-32 are provisionally rejected under the non-statutory obviousness-type double patenting grounds over co-pending application 11/410,105 for the reasons noted at pages 10-11, paragraphs 20-22, of the Office Action.

In the event that co-pending application 11/410,105 issues prior to issuance of this application (09/685,138), Applicant reserves the right to timely submit a Terminal Disclaimer as needed to secure the allowance of this application (09/685,138).

However, in response, Applicant respectfully requests reconsideration and withdrawal of the instant provisional rejection as being premature in view of the fact that co-pending application (11/410,105) has yet to issue.

Conclusion

It is respectfully submitted that a full and complete response has been made to the outstanding Office Action and, as such, there being no other objections or rejections, this application is in condition for allowance, and a notice to this effect is earnestly solicited.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided below.

Serial No.: 09/685,138
Docket No.: 112-1001
Draft Amendment dated November 20, 2006
Reply to the Office Action of October 18, 2006

Please charge the necessary claims fees of \$150.00 for the addition of new claims 33-42 to our Deposit Account No. 50-2827. If any further fees are required in connection with the filing of this amendment, please charge the same to our Deposit Account No. 50-2827.

Respectfully submitted,

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Enclosures:

- Legible oath or declaration (1 page)
- Copy of cited pages of MacHASP (2 pages)
- Copy of cited pages depicting a picture of a MacHASP USB device (however, there is no date on these pages) (2 pages)